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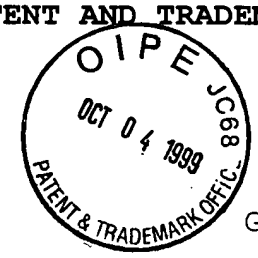
PATENT
Attorney Docket No. 22789-XS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:

Ross, et al.

Serial No.: 09/134,417 Group Art Unit: 1614

Filed: August 14, 1998 Examiner: V. Kim

For: **PIPECOLIC ACID DERIVATIVES FOR VISION AND MEMORY DISORDERS**

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated September 6, 1999. The one month shortened statutory period for response is set to expire on October 6, 1999.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-26 to one of the following inventive groups under 35 U.S.C. 121:

I. Claims 1-10, 21, and 23-24, drawn to a method of treating vision disorders, comprising administering an effective amount of a pipecolic acid derivative, classified in class 514.

II. Claims 1-4, 6-10, and 23-24, drawn to a method of treating memory disorders, comprising administering an effective amount of a pipecolic acid derivative, classified in class 514.

III. Claims 11-20, 22, and 25-26, drawn to a composition containing a pipecolic acid derivative, classified in class 514.

As the basis for this restriction requirement, the Official Action states the following:

> 2. Inventions I, II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP § 806.05(h)). Because these inventions are distinct for the reasons given above and the search required for Group I and II are not required for Group III. A reference which anticipates the invention of Group I and II would not render the invention of Group III obvious, absent ancillary art, restriction for examination purposes as indicated is proper.
>
> 3. In the case, restriction is required to group I and II. The inventions can be shown to be distinct, since group I and II contain patentable distinct two subject matters as follows.
>
> I. Vision related disorers.
> II. Memory related disorders.
>
> Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election of Species. The Examiner has further required election of a single disclosed species of pipecolic acid derivative, for prosecution on the merits if no generic claim is

finally held to be allowable.

PROVISIONAL ELECTION

Applicants provisionally elect Group I, Claims 1-10, 21, and 23-24, drawn to a method of treating vision disorders, and the compound 3-phenylpropyl (2S)-1-(3,3-dimethyl-2-oxopentanoyl)hexahydro-2-pyridinecarboxylate as the elected species. The elected species is a compound of formula VI, wherein R_2 is 3-phenylpropyl. Claims 1-5 and 10 are readable on the elected species.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement.

First, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required.

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.

The Examiner has not indicated on the record how the nature and extent of the related art is too great to be searched in full without imposing a serious burden.

inventive groups I-III, a complete and thorough search for any one of the inventive groups would require searching the art areas appropriate to the other inventive groups. All of the inventive groups are directed to methods of using, or compositions comprising, a pipecolic acid derivative. As the Examiner concedes, all of the inventive groups fall under class 514. Since a search of each of the inventive groups I-III would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims.

Finally, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the inventive groups, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, she is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,

NATH & ASSOCIATES

Date: October 4, 1999

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